



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/786,196

02/25/2004

Anthony J. Saliba

12778US03

2400

23446

7590

03/24/2008

MCANDREWS HELD & MALLOY, LTD

500 WEST MADISON STREET

SUITE 3400

CHICAGO, IL 60661

EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

03/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,196

Applicant(s)

SALIBA, ANTHONY J.

Examiner

JAGDISH N. PATEL

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-61 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 4/6/05.

Response to Amendment

2. Claims 1, 14, 17, 20,35 and 55 have been amended. Claims 1-61 remain pending.

Response to Arguments

3. Applicant's arguments with respect to rejection of claims under 35 USC 101 have been fully considered in view of the amended claims and supporting remarks.

Regarding claim 1, the applicant states that because claim 1 involves a machine (e.g. an Edrop system) which renders it statutory under 101. Which Comiskey, sets standard for the process claim to be statutory process by involvement of a machine, the claim must also satisfy the requirement that the invention as claimed must also produce a useful, concrete, and tangible result (MPEP 7.05.01). See also Overview of Interim Guidelines for Subject Matter Eligibility at the following link.

http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html

See also State Street Bank, 149 F.3d at 1373

("[W]e hold that the transformation of data . . . by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm." (emphases added)); Alappat, 33 F.3d at 1544 ("This is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible result." (emphases added));).

In the instant case, submitting a contra order based on the option order and the contemporaneously are treated as data gathering steps. The machine (Edrop) does not transform the contemporaneously received copy of the option order into a contra order (the Edrop system r contemporaneously receives the option order), however, there is no indication that the Edrop system transform the option order into a contra-order. Broadly interpreted, the claim recites that the Edrop system is used merely as a conduit to submit the contra-order to the market. The claim is silent as to where the contra order is obtained from or generated. Broadly interpreted, the contra order is manually calculated, i.e. based on a human thought and judgment and therefore not concrete.

On the other hand, generating the contra order using the Edrop system and based on the received copy of the option order would satisfy the requirement of "concrete tangible and useful" result.

The applicant, on p. 16 argues that claim 1 recites submitting a contra-order based on the option order through the Edrop system to the market for fulfillment. However, as explained above, this process alone is treated as routine data gathering and communication process. The Edrop system does not transform the option order in to a contra order as in State Street discussed supra. Therefore, this argument in regard to the claim 1 being statutory is not persuasive.

The examiner has withdrawn the rejections of the pending claims under 35 USC 112 (second) and under 103(a) over Walker.

The examiner also has withdrawn rejection of claims 14-61 under 35 USC 101 rendering these claims allowable.

Claim Rejections - 35 USC § 101

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. (see examiner's Response to the Applicant's arguments presented above).

Allowable Subject Matter

3. Claims 14-61 are allowed.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693